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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,288	08/20/2003	Francis Luca Conte	23FLC31	4031
20185	7590	02/07/2007	EXAMINER	
FRANCIS L CONTE 6 PURITAN AVENUE SWAMPSCOTT, MA 01907			ROWAN, KURT C	
			ART UNIT	PAPER NUMBER
			3643	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/07/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 10/643,288	Applicant(s) CONTE, FRANCIS LUCA	
	Examiner Kurt Rowan	Art Unit 3643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 5, 6 and 8-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5, 6, 8-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, 5, 6, 8, 10, 11, 12, 13, 14, 17-20, 21, 22, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over White (US 1779507) in view of Watkins (US 2642057).

The patent to White shows an insect swatter having an elongated rod 1 having a proximal end at extension 10 and a distal end 3 as shown in Fig. 1. White shows an elastic lash including a pair of annular rubber bands as disclosed in lines 87-90 on page 1 joined together at knots 19, 19 there between. White shows three rubber bands but also contemplates 1 or 2. The proximal end is fixedly joined to the rod distal end 4 and an opposite end sized for being elastically stretched from the rod distal end to adjacent the rod proximal end so that release of the lash distal end spontaneously contracts the lash for swatting the lash distal end against an insect. In White, the rubber bands can be considered to fixedly attached or joined to the rod distal end since in the position shown in Fig. 1, the front rubber band is attached to the front sight 4 until the swatter's trigger is pulled. White does not show a keyhole slot, but uses the front sight to attach the rubber bands. The patent to Watkins shows a rubber band gun having a keyhole

slot 34 to dispose a rubber band 14 therein. In reference to claims 1, 7 and 17-20, 21, it would have been obvious to provide White with a keyhole slot as shown by Watkins since merely one mechanically equivalent fastening means is being exchanged for another and the function is the same. Further, in reference to claim 1, White does not disclose that the rubber bands are identical, but it would have been obvious to employ identical rubber bands since the function is the same and no showing of unexpected results was made. Fig. 1 of White shows the rubber bands retained to the distal end of the rod. White shows the distal end of the rubber bands sized to be stretched to the proximal end of the rod. In reference to claim 8, the combination of White as modified by Watkins performs the method as recited. In reference to claim 11, White shows a thumb grip 9. In reference to claim 12, White shows springs 15, 16 joined between the trigger and the handgrip. White shows the trigger being pivotable between a cocked position while holding the latch in a cocked position and a fired position for releasing the latch. In reference to claim 13, the combination of White in view of Watkins performs the recited method. In reference to claim 15, White does not disclose the cocked length is at least three times the unstretched length, but it would have been obvious to stretch the rubber band as far as possible to its maximum stretchable length to obtain maximum range from the rubber band gun. In reference to claim 16, White contemplates the first and second bands having equal lengths to position the knot midway between the cocked length. In reference to claim 18, White shows a handgrip 2 joined to the proximal end of the rod opposite the distal end of the rod. White shows a latch 10 pivotally joined to the handgrip for releasably latching the lash second loop.

White shows a latch stop 14 which prevents the latch 10 from moving until the trigger 13 is pulled. White shows a trigger 13 operatively joined to the latch for releasing the latch upon pulling the trigger. In reference to claim 19, White shows three rubber bands joined together in series at a pair of knots. Inherently the collective spring rate is equal to the reciprocal of the sum of the reciprocals of the spring rates of each of the rubber bands. In reference to claim 20, the rubber bands of White appear to be identical in size, cross section, and material composition and have equal lengths and the knot is midway between the first and second and third loops.

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over White in view of Watkins as applied to claims 1, 21 above, and further in view of Robinson (US 102,594).

The patent to White shows a rubber band gun as discussed above and does not show a keyhole slot. The patent to Watkins shows an upwardly extending key hole slot 34. The patent to Robinson shows a swatter having an elastic cord C which is taken to be the equivalent of a rubber band and a rod having distal and proximal ends. Robinson shows a keyhole slot extending downwardly at the front of the gun to mount the elastic cord in as shown in Figs. 1-2. In reference to claim 9, it would have been obvious to provide the swatter of White as modified by Watkins with a downwardly extending keyhole slot as shown by Robinson since merely one mechanically equivalent key hole

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slot is being substituted for another and the function is the same. White inclines the lash substantially straight as shown in Fig. 1.

3. Claims 1, 3, 5, 6, 8, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watkins in view of White. The patents to Watkins and White show rubber band guns and have been discussed above. In reference to claims 1 and 17, Watkins shows all of the elements recited in claim 1 such as the elongate rod 10 having a slot 34 at a distal end with the exception of the elastic lash being a pair of annular rubber bands joined together at a knot there between. White shows a rubber band gun having a pair of annular rubber bands joined together at a knot there between. It would have been obvious to provide Watkins with a pair of rubber bands as shown by White for the purpose of extending the range of the rubber band gun and/or reduce the stress on the rubber bands since by using two the stress would be reduced. In reference to claim 3, it is not clear if the pin 18 of pivots, but it would have been obvious to provide Watkins with a pivoting latch as shown by White for the purpose of a crisp release of the latch to increase the accuracy of the rubber band gun. In reference to claim 5, both Watkins and White show gun handgrips such as 12 in Watkins. It would have been obvious to pivotally join the latch to the handgrip for the purpose of leasing the lash near the user's hand. In reference to claim 6, the combination of Watkins in view of White performs all of the method steps recited. In reference to claim 9, Watkins shows the keyhole slot extending vertically upward while claim 9 recites that the slot is open downwardly. However, it would have been obvious to reverse the slot of Watkins to open downwardly since the function is the same and no

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stated problem is solved. See *In re Japikse*, 86 USPQ 70 which states that the rearrangement of the location of parts is obvious. In reference to claim 11, White shows a thumb grip 9 extending generally perpendicularly from the latch 10. In reference to claim 12, White shows spring 16 between the tripper 13 and the handgrip 2. The trigger is pivotable between a cocked position holding the latch and a fired position releasing the latch. In reference to claim 15, Watkins and White do not disclose that the cocked length is at least three times the length of the unstretched lash, but it would have been obvious to employ a cocked length of three times the unstretched length since the greater amount the rubber band is stretched the more energy is stored which would aid in the range of the rubber band gun. Note Watkins, column 3, lines 29-37. In reference to claim 16, White appears to show the first and second rubber bands as having equal lengths and the knot is positioned midway between the cocked length. However, White does not state this. At any rate, it would have been obvious to provide the rubber band gun of Watkins with two or three knotted rubber bands as disclosed by White having equal lengths for the purpose of extending the range of the rubber band gun. In reference to claim 19, inherently the rubber band gun of Watkins as modified by White would have a spring rate equal to the reciprocal of the sum of the of the reciprocal of the spring rates of each of the rubber bands. In reference to claim 20, White does not disclose if the rubber bands are the same size, have the same cross-section and material composition. However, it would have been obvious to provide the rubber band gun of Watkins as modified by White with identical rubber bands and to position the knot

midway between the first and second loop since the function is the same and no showing of criticality was made.

***Response to Arguments***

4. Applicant's arguments filed November 15, 2006 have been fully considered but they are not persuasive. Applicant's response overcomes the rejection under 35 USC 102 over White. Applicant argues that White does not show that the lash is fixed, but clearly Watkins shows the lash fixed to an end of toy gun in inclined slot 34. However, since the rubber bands of White are mounted on the gun and the gun can be moved and the rubber bands will also move with the gun, the rubber bands can be thought of as being fixed on the gun. As to the terms proximal and distal, White has one end which can be considered as the proximal end and the other end can be considered as the distal end. Applicants arguments with respect to claims 4 and 6 have been noted, but claim 4 has been canceled. It should be pointed out in regard to White not disclosing a teaching of its use, White shows structure capable of performing the applicant's intended use of the present invention and the fact that White does not disclose applicant's use is not material to article claims. Further applicant has submitted no evidence that White would not function to swat insects. In response to applicant's argument that White is not intended to swat insects, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.



In response to applicant's argument that White and Watkins and Robinson are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, White and Watkins are reasonably pertinent to the particular problem with which applicant was concerned. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Applicant argues that the rubber bands of White are not identical because their lengths are different, but it should be pointed out that patent drawings are not to scale unless specifically stated to be and conclusions can not be drawn from the drawings as to the size of the rubber bands. The bands being formed of old inner tire tubes is stated to be permitted and clearly those tubes could be considered in 1930 to be identical since quality control is likely to be better now than then. Further, White discloses rubber bands in column 2, line 87. White also discloses that the use of two rubber bands is contemplated so the knot or connection between

them is going to be inherently at the midpoint between the first and second rubber bands. Applicant argues that Robinson does not have a key hole slot, but two projections extend from the bottom of the barrel of Robinson which forms a slot which a key could be inserted into. Hence, Robinson shows a key hole slot. Applicant states that the combination of references such as Robinson and White would be inoperative but provides not evidence, merely speculation. In response to applicant's argument that White and Robinson could not be combined, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Rowan whose telephone number is (571) 272-6893. The examiner can normally be reached on Monday-Thursday 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on (571) 272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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A handwritten signature in black ink that reads "Kurt Rowan". The signature is fluid and cursive, with a long horizontal stroke at the end.

Kurt Rowan  
Primary Examiner  
Art Unit 3643

KR